

REMARKS

The following remarks are responsive to the February 23, 2007 Office Action. Claims 1-2 have been amended and Claim 3 remains as originally filed. As a result, Claims 1-3 remain pending in the present application. Applicants respectfully request the Examiner to reconsider the application in view of the following amendments and remarks.

Response to Rejection of Claims 1 and 2 under 35 U.S.C. § 102(e)

In the July 6, 2006 Office Action, the Examiner rejected Claims 1 and 2 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,544,249, issued to Yu et al. ("Yu"). The Examiner argues that Yu teaches that the microfistula implant is made of a gelatin material ...[and] therefore, the implant is fully capable of being disposed in the anterior chamber of the eye at any angle. (Office Action, Pg. 5).

Applicants have amended Claim 1. Applicants submit that Yu does not disclose each and every limitation recited in amended Claim 1. For example, Applicants submit that Yu fails to disclose, among other things, an implant comprising an inflow portion "wherein a long axis of the inflow portion is disposed at an angle to a long axis of the outflow portion when the implant is releasably held by the applicator," as recited in amended Claim 1 (emphasis added).

Yu discloses an applicator comprising an outer tube, an inner tube and a pusher wherein the implant is housed inside the outer tube and the inner tube is used to push the implant from the outer tube to its final position. (Col. 6: Lns 37-47). As depicted in Yu, the outer tube comprises a straight trocar for penetrating the cornea and sclera, thus, the Yu applicator can only be used to insert implants having a linear shape while the implant is held by the applicator. Accordingly, Yu does not disclose an implant comprising an inflow portion "wherein a long axis of the inflow portion is disposed at an angle to a long axis of the outflow portion when the implant is releasably held by the applicator," as recited in amended Claim 1 (emphasis added).

Moreover, Applicants note that Yu further discloses the "the material [gelatin] has sufficient rigidity to withstand the implantation process, but be absorbed after a controllable period. (Col 5: Lns 63-66). Thus, Applicants respectfully submit that Yu discloses a gelatin material for providing a rigid implant that will dissolve after a controlled period, not a flexible implant.

Appl. No. : 10/782,382
Filed : February 19, 2004

Therefore, Applicants submit that Claim 1 is patentably distinguished over Yu. Claim 2 depends directly from Claim 1 and is therefore patentable over the cited art for at least the same reasons as Claim 1. Applicants respectfully request the Examiner to withdraw the rejection of Claims 1 and 2 and pass these claims to allowance.

Response to Rejection of Claim 3 under 35 U.S.C. § 103(a)

In the February 23, 2007 Office Action, the Examiner rejected Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Yu in view of U.S. Patent No. 6,827,700 issued to Lynch et al. (Lynch). Applicants respectfully traverse this rejection.

As discussed above, Applicants submit that amended Claim 1 is patentable over Yu. Applicants further submit that Lynch does not disclose or suggest the limitations of amended Claim 1 which were not disclosed or suggested by Yu. For example, the Examiner states that a flexible implant that has a basic L-shape (such as that of Lynch) would be capable of being straightened and inserted into a straight applicator. However, as discussed above, the Yu patent discloses a tube comprising a straight trocar for penetrating the cornea, thus, the implant has a linear shape while the implant is releasably held by the applicator. Thus, the Lynch implant cannot be combined with the Yu applicator to obviate an implant comprising an inflow portion “wherein a long axis of the inflow portion is disposed at an angle to a long axis of the outflow portion when the implant is releasably held by the applicator,” as recited in amended Claim 1 (emphasis added).

Therefore, amended Claim 1 is patentable over the combination of Lynch and Yu. Claim 3 depends directly from Claims 1 and therefore, is patentable for at least the same reasons that amended Claim 1 is patentable over the applied art. Accordingly, allowance of Claim 3 is respectfully requested.

Double Patenting

The Examiner provisionally rejected Claims 1-3 under the doctrine of obviousness-type double patenting. The Examiner asserted that the Claims 1 and 2 were not patentably distinct from Claims 1, 3 and 5 of co-pending Application Ser. No. 11/121,584. The Examiner also asserted that Claim 3 was not patentably distinct from Claim 5 of co-pending Application Ser. No. 10/634,213 in view of Lynch, U.S. Patent No. 6,827,700. Applicants will file a terminal disclaimer when the provisional nonstatutory obviousness-type double patenting rejection is the

Appl. No. : 10/782,382
Filed : February 19, 2004

only rejection remaining in the application, as provided at M.P.E.P. § 804, subsections I.B. The Applicants respectfully request that the Examiner provide the Applicants the opportunity to file a terminal disclaimer once allowable subject matter has been determined.

CONCLUSION

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. Applicants have made a good faith effort to respond to the outstanding Office Action. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is cordially invited to contact Applicants' attorney, at the telephone number below, to resolve any such issues promptly.

Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Additionally, Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Furthermore, Applicants have distinguished Yu based on structural differences between the Yu disclosure and the claimed subject matter; however Applicants reserve the right to antedate the Yu reference in the future, in related cases or for claims relating to the same or similar subject matter.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 28, 2007

By: Jennifer M. Pascua

Jennifer M. Pascua
Registration No. 56,489
Attorney of Record
Customer No. 20,995
(949) 760-0404